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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,324	12/15/2004	Eric Deguyon Taylor	BA9308USPCT	6745
7590 07/20/2007				
David E Heiser E I du Pont de Nemours & Company Legal Patents Wilmington, DE 19898				
			EXAMINER HABTE, KAHSAY	
			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 07/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/518,324

Applicant(s)

TAYLOR, ERIC DEGUYON

Examiner

Kahsay Habte

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/10/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) 10,11,20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,7-9 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 3-4 and 7-21 are pending in this application.

Election/Restriction

2. Applicant's election with traverse of Group I, Claims 1-9 filed 2/6/2007 is acknowledged. The restriction requirement was made FINAL in the previous Office Action.

Applicants argue, "there was no discussion of J as a special technical feature distinguishing Group I from the other claim groups. Moreover, although election of a single disclosed species was required in the event Applicants elected Group II, all Js were apparently included within Group II". The examiner disagrees with applicant's argument. As set forth in the restriction requirement, inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The special technical feature of Group I is a benzo[1,3]oxazinone ring attached to a pyrrole derivative (5-membered ring with one nitrogen) is different from the special technical feature of Group II. The special technical feature of Group II is other fused oxazinones e.g. K = pyrido, pyrrole, etc. and J = alkyl, halogen, phenyl, or other heterocyclic rings and is different from the special technical feature of Group I.

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In regard to the argument that all Js were included in Group II, the examiner requested a single disclosed species to initiate a search or to transfer the case. Because the Js are included in Group II does not mean the examiner has to search all the Js in Group I. Election of a single disclosed species is a standard procedure, when an invention is very broad or unsearchable. If applicants had been elected Group II, further restriction might have been required.

Since the restriction requirement were made FINAL in the previous Office Action, applicants have to delete the non-elected subject matter e.g. from claims 8 and 12 and delete claims 10-11 and 20-21 or file a petition for the restriction requirement.

Claims 10-11 and 20-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed.

Note that new claim 20 is not drawn to a method of preparing benzo[1,3]oxazinone ring attached to a pyrrole derivative (5-membered ring with one nitrogen). It is drawn to a method of using Formula 1a in making the intermediate compound of Formula III.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter from is recommended in response to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4, 7-9 and 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

- a. Regarding claim 12 (page 6, line 15), the phrase "optionally including" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Response to arguments

Applicant's argument filed 07/10/2007 has been fully considered but it is not persuasive.

Applicants argue that the term "including" as used in Original claim 5 is not indefinite and "optionally including" is illustrated in the application itself. The examiner disagrees with applicant's argument. There is no guidance in the specification for such phrase. It is recommended that applicants amend the claim as "optionally with" to overcome this rejection.

b. In claims 13 and 16, the phrase "wherein the pyridine compound is selected from the groups consisting of pyridine, quinoline, isoquinoline and pyridine substituted with alkyl" is not clear. How can one select a pyridine compound from a pyridine? How can a pyridine compound selected from a quinoline compound that is bicyclic? Note that in claim 12, the claim recites "in the presence of pyridine compound" not in the presence of quinoline or isoquinoline compounds.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

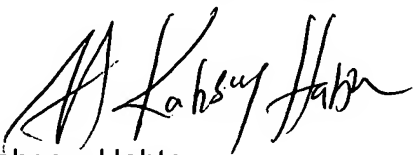
Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571)-272-0667. The examiner can normally be reached on M-F (9.00- 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', is written over a horizontal line.

Kahsay Habte
Primary Examiner
Art Unit 1624

KH
July 16, 2007